



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,292	09/28/2005	Isabel Rego Santos	1660 WO/US	1556
7590		07/02/2008	EXAMINER	
Jeffrey S Boone Mallinckrodt Inc 675 McDonnell Boulevard PO Box 5840 St Louis, MO 63134			SCHLIENTZ, LEAH H	
			ART UNIT	PAPER NUMBER
			1618	
			MAIL DATE	DELIVERY MODE
			07/02/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/551,292	SANTOS ET AL.
	Examiner Leah Schlientz	Art Unit 1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 17 April 2008.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-26 and 36-43 is/are pending in the application.
 4a) Of the above claim(s) 4,5,8-11,13-26,37,39 and 40 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-3,6,7,12,36,38 and 41-43 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 28 September 2005 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____

5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

Acknowledgement of Receipt

Applicant's Response, filed 4/17/2008, in reply to the Office Action mailed 12/21/2007, is acknowledged and has been entered. Claims 1 – 26 and 36 – 43 are pending, of which claims 4, 5, 8 – 11, 13 – 26, 37, 39 and 40 are withdrawn from consideration at this time as being drawn to a non-elected invention. Claims 1 – 3, 6, 7, 12, 36, 38 and 41 – 43 are readable upon the elected invention and are examined herein on the merits for patentability.

Response to Arguments

Applicant's arguments, see pages 2 – 4 of the Response, with respect to the rejection of claims 1 – 3, 6, 7, 12 and 41 – 43 under 35 U.S.C. 103(a) as being unpatentable over Alves *et al.* (*J. Chem. Soc. Dalton Trans.*, 2002, p. 4714 - 4719), in view of Hawthorne (US 5,066,479), have been fully considered but they are not persuasive for reasons set forth hereinbelow.

Applicant's arguments, see pages 2 – 4 of the Response, with respect to the rejection of claims 36 and 38 under 35 U.S.C. 103(a) as being unpatentable over Alves *et al.* (*J. Chem. Soc. Dalton Trans.*, 2002, p. 4714 - 4719), in view of Merkle *et al.* (US 5,569,769), have been fully considered but they are not persuasive for reasons set forth hereinbelow.

Declaration under 37 CFR 1.132

The declaration filed on 4/17/2008 under 37 CFR 1.132 has been considered but is ineffective to overcome the Alves reference.

The Alves reference is a statutory bar under 35 U.S.C. 102(b) and thus cannot be overcome by an affidavit or declaration under 37 CFR 1.132.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 – 3, 6, 7, 12 and 41 – 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alves *et al.* (*J. Chem. Soc. Dalton Trans.*, 2002, p. 4714 - 4719), in view of Hawthorne (US 5,066,479), for reasons set forth in the Office Action mailed 12/12/2008.

Claims 36 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alves *et al.* (*J. Chem. Soc. Dalton Trans.*, 2002, p. 4714 - 4719), in view of Merkle *et al.* (US 5,569,769), for reasons set forth in the Office Action mailed 12/12/2008.

Applicant argues that the Alves publication was first published as an advance article on the internet on November 8, 2002, and that the present application claims priority to European Patent no. 03076106.8, filed April 15, 2003. Applicant contends that this application was filed less than one year after the publication date of the Alves publication, and that the Alves publication is only available as a reference under 35

U.S.C. 102(a). Applicant cites the 132 declaration, and contends in accordance with MPEP 715.01(c), the Alves publication is not "by another" and thus is not available as prior art under 35 U.S.C. 102(a), and requests that the Alves publication be removed from consideration.

This is found non-persuasive. The examiner respectfully submits that, while the declaration has been fully considered, it is ineffective to overcome the Alves reference because the Alves reference is a statutory bar under 35 U.S.C. 102(b) and thus cannot be overcome by an affidavit or declaration under 37 CFR 1.132.

Applicant is respectfully pointed to the conditions of patentability and loss of right to patent under 35 U.S.C. 102:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the **date of application for patent in the United States**.

The effective U.S. filing date of the instant application (the '292 application) is the 371 filing of PCT/US04/11685 (April 15, 2004). While Applicant's claim to foreign priority is acknowledged, the Alves reference was published more than one year prior to the **application for patent in the United States**, and thus qualifies as prior art under 35 U.S.C. 102(b).

Allowable Subject Matter

Claims 1 - 3, 6, 7, 12, 36, 38 and 41 - 43 are free of the prior art to the extent that they read upon the elected species. However, in accordance with Markush

practice, the search was expanded to cover additional non-elected species within the scope of the pending claims. Grounds for rejection over non-elected species are maintained as in the Office Action mailed 12/12/2007.

Conclusion

No claims are allowed at this time.

Although Applicant's arguments as set forth in the aforementioned Response have been fully considered, they are deemed unpersuasive. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leah Schlientz whose telephone number is 571-272-9928. The examiner can normally be reached on Monday - Friday 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on 571-272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael G. Hartley/
Supervisory Patent Examiner, Art Unit 1618

LHS